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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/944,604

08/31/2001

John C. Gerdes

XTR004 CIP

2327

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7590

08/27/2002

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EXAMINER

WHISENANT, ETHAN C

ART UNIT

PAPER NUMBER

1634

DATE MAILED: 08/27/2002

6

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/944,604

Applicant(s)

GERDES ET AL.

Examiner

Ethan Whisenant, Ph.D.

Art Unit

1634

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-142 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-142 are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                             | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). ____.  |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)         | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____. | 6) <input type="checkbox"/> Other: _____                                    |

**ELECTION/RESTRICTION**

- 1.**     **Claim(s) 1-142** is/are pending in the application.

**ELECTION/RESTRICTION**

- 2.**     Restriction to one of the following inventions is required under 35 U.S.C. 121:
- I.**     **Claims 1-18** drawn to a method of archiving nucleic acid, classified in at least Class 435, subclass 6.
  - II.**    **Claims 19-37** drawn to a method of amplifying one or more target nucleic acids, classified in at least Class 435, subclass 91.2.
  - III.**   **Claims 38-50** drawn to a method of purifying a nucleic acid present in a sample comprising non-nucleic acid contaminants, classified in at least Class 435, subclass 6 and Class 536, subclass 25.4.
  - IV.**    **Claims 51-60** drawn to a method of concentrating the nucleic acid present in a sample, classified in at least Class 435, subclass 6 and Class 536, subclass 25.4.
  - V.**     **Claims 61-70** drawn to a method of capturing a target nucleic acid via hybridization, classified in at least Class 435, subclass 6.
  - VI.**    **Claims 71-94** drawn to a method of coating the surface of a plastic material with a solid phase matrix, classified in at least Class 435, subclass 6.
  - VII.**   **Claims 95-133** drawn to a method of coating the surface of a oxide substrate with a solid phase matrix as well as the product made by said process, classified in at least Class 435, subclass 6.
  - VIII.**   **Claims 134-142** drawn to a kit for nucleic acid manipulation, classified in at least Class 435, subclass 6.

- 3.** The inventions are distinct, each from the other for the following reasons.

**Inventions I -VII** are directed to patentably distinct methods with different goals, different intermediate steps and different end results (see MPEP § 806.04, MPEP § 808.01). The search for one will not necessarily result in a search for others.

**Invention VIII** is directed to a product (i.e. kit ) which is patentably distinct from the methods of Groups I-VII. The product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). For example, the product as claimed can be used as a paperweight or a doorstop.

- 4.** Because these inventions are distinct for the reasons given above and they will require non-coextensive literature searches, restriction for examination purposes as indicated is proper.

- 5.** Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

- 6.** Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a diligently-filed petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(h).

- 7.** Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ethan Whisenant, Ph.D. whose telephone number is (703) 308-6567. The examiner can normally be reached Monday-Friday from 8:30AM -5:30PM EST or any time via voice mail. If repeated attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, W. Gary Jones, can be reached at (703) 308-1152.

The fax number for this Examiner is (703) 746-8465. Before faxing any papers please inform the examiner to avoid lost papers. Please note that the faxing of papers must conform with the Notice to Comply published in the Official Gazette, 1096 OG 30 (November 15, 1989). Any inquiry of a general

nature or relating to the status of this application should be directed to the group receptionist whose telephone number is (703) 308-0196.

A handwritten signature in black ink, appearing to read 'E. Whisenant', with a long horizontal flourish extending to the right.

**ETHAN C. WHISENANT**  
**PRIMARY EXAMINER**